



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of :  
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Shigeo Ozawa : Confirmation No. 8766  
:  
U.S. Application Serial No. 09/519,999 : Group Art Unit: 1761  
:  
Filed: March 6, 2000 : Examiner: Madsen, Robert A.  
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For: AN ACCOMODATION BAG

Box Patent Appeal Brief  
Commissioner for Patents  
U.S. Patent and Trademarks Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Appellant hereby files this Reply Brief to the Examiner's Answer mailed October 20, 2004.

This Reply Brief is transmitted in triplicate.

Appellant respectfully traverses all Examiner's arguments indicated in the "Grounds of Rejection" and "Response to Argument" sections of the Examiner's Answer. In the following section, Appellant will address the Examiner's arguments indicated in the "Response to Argument" section. Any remaining issues are believed sufficiently and adequately treated in the Appeal Brief filed July 15, 2004.

Claims 31 and 33

The Examiner repeated his position that “there is no discussion in the specification of vapor contacting, let alone submerging a portion of the second inner bag”. Appellant again submits that the Examiner misinterpreted claims 31 and 33, the plain meaning of which requires submergence of a portion of the second inner bag in the heated liquid which has escaped the first inner bag as vapor.

The Examiner stated that the figures as filed cannot be relied upon as a support for the claim limitations of claims 31 and 33, because the vapor is not labeled or illustrated in the figures. Appellant respectfully submits that the figures provide solid support for correctly interpreted claims 31 and 33 as presented above and in the July 15, 2004 Appeal Brief, page 7, lines 9-13 from bottom. Note also the slanted, double lines in FIG. 1 and the horizontal, double lines in FIG. 2 which illustrate that the contents (i.e., liquid) of inner bag 3 have escaped to the interior of outer bag 1 (FIG. 2) to submerge portions of inner bags 7.

Claim 20

The Examiner argued that *Ooyama* implicitly teaches the first inner bag having a vapor release hole in the upper part thereof, because the reference’s other bag, i.e., the outer bag, has such a hole. The Examiner’s rationale is flawed because it has failed to provide “a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). The fact that the *Ooyama* outer bag might have a vapor release hole in the upper part thereof does not necessarily lead a person of ordinary skill in the art to the conclusion that the *Ooyama* first inner bag in the “steaming ” embodiment must have the same or similar hole. It should further be noted that the *Ooyama* outer bag’s vapor release hole, which is arranged to release steam in a regulated manner and tends to retain most of the produced steam in the outer bag (page 13, lines 10-13), is not applicable to the “steaming” embodiment’s first inner bag which must release most of the produced steam in order to cook the food.

Appellant therefore submits that a person of ordinary skill in the art would find the teachings of *Ooyama* limited to, at best, a liquid releasing hole formed at the bottom of the first inner bag, as argued in the July 15, 2004 Appeal Brief, page 11, the last two paragraphs. Such a liquid releasing hole formed at the bottom of the *Ooyama* first inner bag would allow all or at least a substantial part of the heated liquid to escape the first inner bag to produce a sufficient amount of vapor to steam the food.

The Examiner's argument found in page 7, lines 1-10 from bottom of the Examiner's Answer is not understood and traversed as argued in the July 15, 2004 Appeal Brief, the paragraph bridging pages 9-10.

#### Claim 23

The Examiner argued that *Ooyama* teaches a liquid drain hole in the outer bag in both embodiments (FIGs. 1-9 and 10-13, respectively). Appellant respectfully disagrees with respect to at least the second embodiment (FIGs. 10-13) because item 71 in FIG. 12 relied upon by the Examiner for the claimed feature is part of the first inner bag, rather than the outer bag. The outer bag in the *Ooyama* second embodiment does not have a liquid drain hole as can be seen in FIGs. 10-13. Since the unshown, "steaming" embodiment of *Ooyama* is a reversal of the second embodiment, the "steaming" embodiment's outer bag, like the outer bag of the second embodiment, does not have a liquid drain hole. This is also consistent with the common knowledge in the art as argued in the July 15, 2004 Appeal Brief, page 12, lines 13-20.

#### Claim 24

The Examiner argued that in the substitution of a second inner bag for the partition sheet in the "steaming" embodiment of *Ooyama*, such a second inner bag would be attached to the two ends (presumably near reference numeral 68 in FIGs. 10-13) of the bottom of the outer bag. Appellant fails to understand why the second inner bag would have to be attached to the outer bag in such an abnormal manner. *Ooyama* specifically discloses in FIGs. 1 and 8 how two inner bags can be best arranged one upon another and the configuration of FIGs. 1 and 8 would be clearly the way a person of ordinary skill in the art would have arranged the inner bags in the Examiner's modified the "steaming" embodiment. Apparently, when the second inner bag is

arranged on top of the first inner bag as disclosed in FIGs. 1 and 8 of *Ooyama*, the second (upper) inner bag cannot be considered to be bonded to the bottom of the outer bag.

Claim 32

The Examiner argued that *Ooyama* implicitly teaches it would not be required to have the food placed entirely above the vapor release hole of the first inner bag. The Examiner actually argued that the “steaming” embodiment of *Ooyama* can be modified to arrange the food below the upper vapor release hole of the first inner bag. This is not a correct argument under 35 U.S.C. 103(a).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Appellant respectfully submits that *Ooyama* fails to suggest the desirability of the claimed arrangement of the food below the vapor releasing hole of the first inner bag. The other references of record also fails to supply the desirability of the claimed invention. The 35 U.S.C. 103(a) rejection of claim 32 is therefore erroneous and should be reversed.

Claim 33

The Examiner argued that in the “steaming” embodiment of *Ooyama* the food is submerged in the vapor. This argument is unrelated to the invention of claim 33 which requires a portion of the second inner bag to be submerged in the heated liquid which has escaped the first inner bag as vapor. Since in the “steaming” embodiment of *Ooyama* the food is entirely placed above the liquid containing bag, the food cannot be submerged in the liquid.

Consideration of this reply brief together with the Appeal Brief filed July 15, 2004 is respectfully requested. Reversal of the Examiner's Final Rejection, in view of the arguments presented in the Appeal Brief and this Reply Brief, is believed appropriate and therefore courteously solicited.

If for any reason this Reply Brief is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned, Appellant's attorney of record.

Respectfully submitted,

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A handwritten signature in black ink that reads "Kenneth M. Berner". The signature is written in a cursive, flowing style.

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